

REMARKS

Reconsideration of the present application is requested. Claims 2-4, 7-15, 20-25, 29-32, 34-36, and 40-43 are pending.

ENTRY OF THIS AMENDMENT AFTER FINAL IS REQUESTED

No new issues requiring further consideration and/or search have been raised by way of this response. To the contrary, Applicants have only amended the claims taking into account the Examiner's comments and to further clarify features previously set forth. No new matter has been added. Accordingly,

entry of this Amendment After Final is requested.

REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

The Examiner rejects claims 2-4, 7-15, 20-25, 29-32, 34-36 and 40-43 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

As previously argued, the Examiner carries the initial burden to establish that an adequate written description of the claimed invention is not present in the original disclosure. *In re Wertheim*, 541 F.2d 257, 263, 191 USPQ 90, 97 (CCPA 1976), MPEP § 2163(II)(A). In doing so, the Examiner must present *evidence or reasons why* a person skilled in the art would not recognize that the written description of the invention provides support for the claims. *Id.* (*emphasis added*).

In the July 10, 2007 Office Action, the Examiner states:

Regarding independent claim 1 and dependent claims, the specification does not appear to describe the complete set of limitations as in the method of claim 1. While each limitation is

described in the specification, the complete process does not appear to be described. Further, the first limitation appears to be independent of the remaining limitations, which also does not appear to be described in the specification.

Moreover, on page 14 of the November 11, 2007 Final Office Action, the Examiner states:

Regarding independent claim 7 and dependent claims, the specification does not appear to describe the complete set of limitations as in the method of claim 7. While each limitation is described in the specification, the complete process does not appear to be described. Further, the first limitation appears to be independent of the remaining limitations, which also does not appear to be described in the specification.

From the above statements, it appears the Examiner's evidence or "reasons," why an adequate written description is not present is that "each limitation is described in the specification," but "the complete process does not appear to be described." Final Office Action at 14. However, this statement itself is contradictory and merely conclusory, without any actual evidence in support of this conclusion.

First, surely one can appreciate that if each limitation or step of a process is described, then the complete process is described. In other words, the complete process is set forth by way of the steps included therein, and thus, the fact that each step/feature/limitation is described establishes that the complete process is described.

Moreover, the "reasons" given by the Examiner (i.e., "While each limitation is described in the specification, the complete process does not appear to be described.") are merely conclusory, but not evidence or reasons why a person skilled in the art would not recognize that the written description

of the invention provides support for the claims. In this portion of the rejection, the Examiner fails to point to a single limitation or step in the claims that is not supported by the detailed description, let alone, provide reasons why such a feature is not supported. Absent any such reasons, one can only conclude that the Examiner believes each individual step in claim 7 is supported by the original disclosure.¹ If each individual step of claim 7 is supported by the original disclosure, the only logical conclusion is that the method of claim 7 is sufficiently supported.

Moving forward, the Examiner argues that Applicants' rebuttal arguments amount to nothing more than allegations that are not supported by facts. Final Office Action at 3. Applicants disagree with the Examiner's statement.

Applicants' rebuttal arguments were not merely allegations without any factual support, but an assertion that the Examiner has not yet met the requisite burden for overcoming the strong presumption that an adequate written description of the claimed invention is present when the application is filed. As discussed above, the absence of evidence or reasons why one of ordinary skill would not recognize that the disclosure provides sufficient support for claim 7, for example, is the only fact necessary to support the conclusion that the Examiner has not overcome the above-discussed *strong presumption* that an adequate written description of the claimed invention is present in the original disclosure.

¹ This is further supported by the Examiner's admission that "each limitation is described in the specification." See, Final Office Action at 14.

Further with regard to claim 7, the Examiner asserts that "the first limitation [of claim 7] appears to be independent of the remaining limitations, which also does not appear to be described in the specification." Final Office Action at 14. Applicants fail to understand this portion of the rejection.

Claim 7 is directed to a method for simulating a technical system. According to this method, a required function is optimized such that a set of setting parameters are optimized. The required function is based on the set of setting parameters and a first set of setting constants. A result is determined as a function of the set of setting parameters and based on a request to an external source, wherein the result is in the form of an influence of the set of setting parameters on the technical system. The result is temporarily stored and the technical system is simulated based on the result and the setting constants.

Given the above-discussion and claim 7 as currently set forth, the first limitation of claim 7 is *not* independent of the remaining limitations. Moreover, as described above, this limitation is sufficiently supported by the disclosure.

Further still, in the November 11, 2007 Final Office Action, the Examiner analyzes the discussion presented in Applicants' October 10, 2007 Response, which was presented to aid the Examiner in understanding the example embodiments described in the application. In particular, the Examiner appears to have searched paragraphs [0021-0026] of Applicants' Specification for *explicit recitation* of each and every sentence in Applicants' explanation. *See*, Final Office Action at 4-6.

Applicants note that the paragraphs referenced in the October 10, 2007 Response were for exemplary purposes only and should not have been relied upon as the sole support for the claimed subject and/or Applicants' argument. Moreover, explicit recitation of the language of each claim is not absolutely necessary so long as the claimed features are supported by the disclosure, which as discussed above, is the case in this application. MPEP § 2163.02 ("The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.").

For example, with respect to the Examiner's allegation that the "result" is in the form of both an influence of the set of setting parameters on the technical system and the influence of the setting constants, (See November 26, 2007 Final Office Action), Applicants refer the Examiner to paragraph [0008] of Applicants' Specification, which states, "the process of determining the value of the required function can be split into determination of the influence of the parameters on the technical system and determination of the influence of the setting constants on the technical system." This supports the recitation of "the result being in the form of an influence of the set of setting parameters on the technical system," as set forth in claim 7, for example.

Although Applicants still do not agree with the Examiner's rejection under 35 U.S.C. § 112 for the reasons set forth above, *Applicants have amended independent claims 7-9, 12 and 13 to further clarify and taking into account the Examiner's comments/confusion.*

For at least the foregoing reasons, withdrawal of this rejection is requested.

PRIOR ART REJECTIONS

Rejection under 35 U.S.C. § 103(a)

Claims 2-4, 7, 9-15, 20-25, 30-32, 34-36 and 41-43 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over "Microsim Pspice A/D & Basics+," June 1997 ("Microsim") in view of U.S. Patent No. 6,327,557 ("Croix") and further in view of "Microsim Pspice Optimizer," June 1997, ("Optimizer"). Applicants traverse this rejection.

Previously, Applicants argued that even in combination, the references fail to teach or suggest determining an "influence of each of a plurality of sets of setting parameters on the technical system," by "checking the external source," as required by claim 7. In response to this argument, on page 8 of the November 11, 2007 Final Office Action, the Examiner states:

Column 5, lines 8-50 [of Croix] appears to teach using SPICE to simulate cells operation at characterization points and creating a characterization table with the points (especially column 5, lines 8-26). This appears to satisfy the limitation, as recited above, determining an "influence of each of a plurality of sets of setting parameters on the technical system," by "checking the external source," as required by claim 7, because SPICE is clearly an external source, and the characterization points are a plurality of sets of setting parameters.

Applicants disagree with the Examiner's characterization of what is disclosed in this portion of *Croix*.

Column 5, lines 8 through 50 of *Croix* discloses measuring cell operation times in response to a preselected number of input transition times and

corresponding output loads. Each input transition time and corresponding output load is referred to as a "characterization point." *Croix* discloses five characterization points. But, in this embodiment of *Croix*, only the input transition time could even arguably be considered a "parameter," because the output load is the resultant output load generated by the system 100, but not an influence on the system. Although *Croix* discloses using multiple values of input transition times, the fact remains that these values, at most, correspond to only a *single* parameter. As a consequence, *Croix* does not disclose "an influence of each of a plurality of sets of setting parameters," since input transition time is at most a single parameter.

The Examiner also relies upon column 9, lines 55-67 and column 10, lines 1-35 of *Croix* to teach the "additional influence," set forth in claim 7.

Columns 9 and 10 disclose a more specific example of the embodiment disclosed in column 5. According to columns 9 and 10 of *Croix*, a response time r is a function of C_l and t_r (see, e.g., *Croix* at col. 9:16-9:17). But, even assuming *arguendo* that C_l and t_r could arguably be considered a single set of parameters (which Applicants do not admit), *Croix* still fails to teach or suggest a "plurality of sets of setting parameters."

The Examiner relies upon *Optimizer* to teach, "simulating the technical system based on the result and the setting constants," as required by claim 7. While *Optimizer* arguably performs a simulation based on certain values R_{Fc} , R_{Bw} , R_{Gain} , *Optimizer* defines the *result* as *center frequency Fc*, bandwidth *BW* and *Gain*. *The simulation is not performed based on these results.* Therefore,

Optimizer does not disclose or fairly suggest at least, "simulating the technical system based on the result and the setting constants," as required by claim 7.

For at least the foregoing reasons, claim 7 is patentable over *Microsim*, *Optimizer* and *Croix* because, even in combination, the references fail to teach or suggest all features of claim 7. Claims 12 and 13 are patentable for at least reasons somewhat similar to those set forth above with regard to claim 7.

Claim 9 recites, "the influence of each of a plurality of sets of setting parameters on the technical system is determined by checking the external source," and thus, is patentable for reasons at least somewhat similar to those set forth above with regard to claim 7. In addition, claim 9 is patentable for the following additional reasons.

Each of *Microsim*, *Optimizer* and *Croix* are arguably directed to simulation methods and software, without any connection to actual experiments. Consequently, none of *Microsim*, *Optimizer* nor *Croix* teach or fairly suggest at least, "*determining a result as a function of the set of setting parameters and based on a request to an external source, the result being in the form of an influence of the set of setting parameters on the technical system, the external source being an experiment*," as required by claim 9.

Moreover, because each of *Microsim*, *Optimizer* and *Croix* are *completely dependent and reliant upon simulations*, but not real world experimental data, an external source that is an experiment would *not* have been obvious to one of ordinary skill. For at least the foregoing reasons, claim 9 is patentable over

Microsim, Optimizer and *Croix* because, even in combination, the references fail to teach or suggest all features of claim 9.

For at least the foregoing reasons, claim 9 is patentable over *Microsim, Optimizer* and *Croix*, taken singly or in combination.

Claims 12 and 13 are patentable over *Microsim, Optimizer* and *Croix* for at least reasons somewhat similar to those set forth above with regard to claim 1.

Claims 2-4, 10, 11, 14, 15, 20-25, 30-32, 34-36, and 41-43 are patentable at least by virtue of their dependency from claims 7, 9, 12 or 13.

Further Rejection under § 103(a)

The Examiner further rejects claims 8, 29 and 40 under 35 U.S.C. § 103(a) as unpatentable over *Microsim, Croix, Optimizer* and U.S. Patent No. 6,606,612 ("Rai"). Applicants traverse this rejection.

In the method of claim 8, a result is determined as a function of a set of setting parameters and based on a request to an external source. The result is in the form of an influence of the set of setting parameters on the technical system. The technical system is simulated based on the result and the setting constants. Afterward, the influence of each of a plurality of sets of setting parameters on the technical system is determined by checking the external source.

The Examiner correctly recognizes that *Microsim* and *Optimizer* fail to teach or suggest at least, determining an "influence of each of a plurality of sets of setting parameters on the technical system," by "checking the external

source," as required by claim 8, but relies upon *Croix* to teach this feature. As discussed above with regard to claims 7 and/or 9, however, *Croix* also fails to teach or suggest this feature. *Rai* is also deficient with regard to this feature. Therefore, even if combined, the references fail to teach or suggest all features of claim 8.

Claims 29 and 40 are patentable by virtue of their dependency from claim 12, and for at least reasons somewhat similar to those set forth above with regard to claim 8.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of the pending claims in connection with the present application is earnestly solicited.

If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Andrew M. Waxman, Reg. No. 56,007, at the number of the undersigned listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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